



11-22-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #73

**IN THE UNITED STATES PATENT AND TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 76/220,909  
Filed: March 7, 2001  
For the Mark: KISS AND MAKE-UP  
Published in the Official Gazette on April 30, 2002  
Applicant: Girl Squared, LLC

Kiss Catalog, Ltd.

Opposer,

v.

Girl Squared, LLC

Applicant

Opposition No. 91152831

Commission for Trademarks  
BOX TTAB NO FEE  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Girl Squared, LLC ("Applicant") by its undersigned counsel, Bell, Boyd & Lloyd LLC, hereby files its Answer and Affirmative Defenses to the Notice of Opposition filed herein by Kiss Catalog, Ltd. ("Opposer"), as follows:

**ANSWER AND AFFIRMATIVE DEFENSES TO OPPOSITION**

1. Opposer, Kiss Catalog, Ltd., is the owner of the intellectual property rights, including trademark rights, pertaining to the musical group KISS, and as such has been engaged in the production of musical entertainment services and in merchandising the term KISS and variations thereof, and the likenesses of the band members on various goods, including necklaces, comic books, photographs, posters, souvenir books, greeting cards, decals, heat transfers, bumper stickers, fan club kits comprising advertising brochures, certificates and souvenirs, cloth patches, buckles, ornamental badges and pins, jigsaw puzzles, paper toys, prerecorded videotapes featuring musical performances and clothing and apparel items.

**ANSWER:** Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 1, and therefore denies the same. Applicant states that merchandising rights and likenesses of band members do not constitute trademarks.

2. Petitioner has used and presently uses the marks "KISS", "KISS ARMY," "KISS KONFIDENTIAL," "KISS PSYCHO CIRCUS," "KISSNATION," "KISSTORY," and "KISS CONVENTION," in connection with the design, sale and distribution of the goods and services identified in paragraph 1.

**ANSWER:** Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 2, and therefore denies same.

3. Petitioner is the owner of the following registrations: "KISS" (Registration No. 1,055,765 dated January 4, 1977); "KISS" (Registration No. 1,153,088 dated May 5, 1981); "KISS" (Registration No. 1,155,932 dated May 26, 1981); "KISS" (Registration No. 1,894,876 dated May 23, 1995); "KISS ARMY" (Registration No. 2,163,803 dated June 9, 1998); "KISS KONFIDENTIAL" (Registration No. 1,916,210 dated September 5, 1995); "KISS PSYCHO CIRCUS" (Registration No. 2,237,588 dated April 6, 1999); "KISS PSYCHO CIRCUS" (Registration No. 1,268,884 dated August 10, 1999); "KISSNATION" (Registration No. 2,106,028 dated October 14, 1997); "KISSTORY" (Registration No. 2,137,991 dated February 17, 1998); "KISS CONVENTION" (Registration No. 1,989,361 dated July 23, 1996); and "KISS CONVENTION" (Registration No. 2,050,016 dated April 1, 1997), which registrations are valid, subsisting and unrevoked. There are additional U.S. registrations pending in Classes 35 and 38.

**ANSWER:** Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 3, and therefore denies same. Applicant states affirmatively that none of these registrations covers "KISS AND MAKE-UP."

4. Since prior to the date of first use alleged in Application Serial No. 76/008,081 [sic] Opposer and its predecessor did use and have continuously used in interstate commerce the mark "KISS" and variations thereof in connection with the various products and services described in paragraph 1 herein extensively throughout the United States. By reason of such extensive use and promotion, Opposer has attained an enviable reputation for high standards of quality, and the mark KISS and variations thereof have become distinctive of and associated in the minds of the trade and purchasing public with the Opposer.

**ANSWER:** Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 4, and therefore denies same. Furthermore, Applicant states that Serial No. 76/008,081 was filed by I.P. International, Inc. to register KISS.COM for television and movie production. This application was allowed on July 23, 2002.

5. Both Applicant's mark and Opposer's mark contain the term "KISS." Applicant's mark is different only by the addition of the terms "AND MAKE-UP" which do not serve to distinguish Applicant's mark. Because the two marks share an identical term and that term is the dominant portion of the mark, both have a similar commercial impression. Furthermore, the services of the Applicant are related and/or identical to the various services and products of Opposer as described in paragraph 1 herein, and are likely to move within the same channels of trade and be purchased by the same class of purchaser. Additionally, the members of the musical group KISS employ distinctive facial make-up for which they are well-known. Therefore, the term "make-up" used in connection with the term "kiss" has become associated with the Opposer. As such, Applicant's mark is likely, when used in association with the services of Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the services of Applicant emanate from, are offered for sale, or are sold by Opposer or under Opposer's approval, sponsorship or control, all to the great damage of Opposer.

**ANSWER:** Applicant admits that its mark and Opposer's mark contain the term "KISS." Applicant denies all remaining allegations contained in Paragraph 5. Applicant further states that the term "KISS" is not a coined term and is widely used on various goods and services by a number of different entities. Applicant further states that its mark KISS AND MAKE-UP is distinguishable from the term "KISS" in appearance, sound, meaning and commercial impression.

6. Opposer believes that Applicant's selection of the mark KISS AND MAKE-UP may take advantage of the nationwide reputation of Opposer and its mark KISS, and combination marks featuring the term KISS, and may take advantage of the goodwill of Opposer gained by extensive and persistent advertising and expenditures of large sums of money therefore, and if continued in commerce, will be likely to confuse, mislead or deceive the trade and members of the public in suggesting to them that Applicant's mark identifies goods and/or services sold, sponsored or approved by Opposer or to suggest falsely a trade connection between Opposer and Applicant.

**ANSWER:** Applicant denies the allegations contained in Paragraph 6.

7. If specified services of Applicant are inferior in quality, there will be irreparable injury to Opposer's valuable goodwill and its registered marks. Furthermore, the use and registration of the mark KISS AND MAKE-UP will dilute the distinctive character of Opposer's valuable registered trademarks, and combination marks featuring the term KISS.

**ANSWER:** Applicant denies the allegations contained in Paragraph 7.

#### **AFFIRMATIVE DEFENSES**

1. Opposer fails to state a claim upon which relief can be granted.
2. Opposer fails to state a claim for dilution because, among other reasons, Opposer has not claimed that its marks were famous on or before the date of filing of Applicant's application.
3. Opposer is estopped from pursuing this opposition because it has acquiesced in Applicant's application for KISS AND MAKE-UP, and is estopped from opposing it by failing to oppose Applicant's prior applications for the identical mark (Serial Nos. 76/042,676, 76/042,344 and 76/042,343), which have now been allowed. Applicant's applications to register KISS AND MAKE-UP were filed on May 5, 2000 and were allowed on November 6, 2001. Copies of TARR

records for each application are attached hereto as Exhibit A. Because Applicant's prior allowed, applications cover related goods and are identical in appearance to its application for KISS AND MAKE-UP, Opposer cannot be damaged within the meaning of Lanham Act § 13.

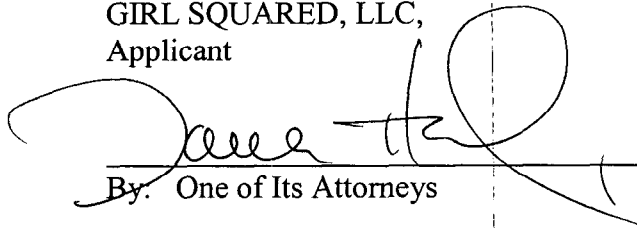
4. Applicant has priority over Opposer with respect to "KISS AND MAKE-UP."

WHEREFORE, Applicant respectfully requests that the Notice of Opposition be dismissed with prejudice in its entirety.

Dated: November 19, 2002.

Respectfully submitted,

GIRL SQUARED, LLC,  
Applicant



By: One of Its Attorneys

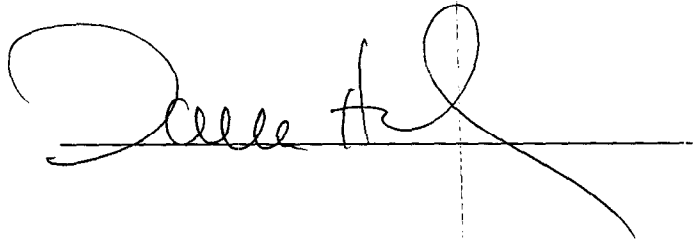
Christopher A. Bloom, Esq.  
Sana Hakim, Esq.  
Kathryn Starshak, Esq.  
BELL, BOYD & LLOYD LLC  
P.O. Box 1135  
Chicago, Illinois 60690-1135  
(312) 372-1121

**CERTIFICATE OF SERVICE**

The undersigned, an attorney, hereby certifies that she caused a copy of Applicant's Answer and Affirmative Defenses to Notice of Opposition to be served upon counsel for Opposer at the following address:

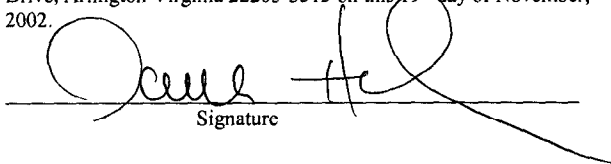
Peter J. Vranum, Esq.  
Janvey, Gordon, Herlands, Randolph & Cox, LLP  
355 Lexington Avenue, 10<sup>th</sup> Floor  
New York, New York 10017

by first class mail, proper postage prepaid, this 19th day of November, 2002.

A handwritten signature in dark ink, appearing to read "Sana Hakim", written over a horizontal line.

**CERTIFICATE OF MAILING**

I, Sana Hakim, do hereby certify that one original and one copy of the foregoing document are being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to the Commissioner for Trademarks, BOX TTAB, NO FEE, 2900 Crystal Drive, Arlington Virginia 22203-3513 on this 19<sup>th</sup> day of November, 2002.

A handwritten signature in dark ink, appearing to read "Sana Hakim", written over a horizontal line.

Signature

BELL, BOYD & LLOYD LLC



11-22-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #73

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shakim@bellboyd.com  
0112405-013

OFFICES IN CHICAGO  
AND WASHINGTON, D.C.

November 19, 2002

**VIA FIRST CLASS MAIL**

Commissioner of Trademarks  
BOX TTAB  
NO FEE  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Dear Commissioner:

Enclosed on behalf of our client, Girl Squared, LLC, please find:

1. One original and one copy of an Answer and Affirmative Defenses to Opposition No. 91152831; and
2. A postcard which we ask that you date stamp and return.

If you have any questions, please correspond with me at the above address and reference attorney docket No. 0112405-013 on all correspondence.

Very truly yours,

Sana Hakim

SH:mcf  
Enclosures

Copies to: Ms. Maria Gallagher  
Ms. Jodi Sweetbaum  
Christopher A. Bloom, Esq.

62 DEC -4 AM 5:30

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 11/19/2002 17:10:28 ET**

**Serial Number:** 76042344

**Registration Number:** (NOT AVAILABLE)

**Mark (words only):** KISS AND MAKE-UP

**Current Status:** A request for the first extension of time to file a statement of use has been granted.

**Date of Status:** 2002-03-11

**Filing Date:** 2000-05-05

**The Notice of Allowance Date is:** 2001-11-06

**Registration Date:** (DATE NOT AVAILABLE)

**Law Office Assigned:** TMO Law Office 110

**Attorney Assigned:**  
SMITH REBECCA A Employee Location

**Current Location:** 701 -Intent To Use Unit

**Date In Location:** 2002-03-11

---

**CURRENT APPLICANT(S)/OWNER(S)**

---

1. Girl Squared, LLC

**Address:**

Girl Squared, LLC  
270 Lafayette St. Suite 1301  
New York, NY 10012  
United States

**State or Country Where Organized:** New York

**Legal Entity Type:** Other

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**GOODS AND/OR SERVICES**

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Children's cosmetics, namely, children's blush, children's eye liner, children's eye shadow, children's mascara, children's face and body glitter, children's self-adhesive body gems, children's face and body powder, children's lipstick, children's lipliner, children's lipgloss, children's moisturizers, children's creams and lotions for use on the hands, face and body, children's nail polish; children's perfume; and children's soap, namely, hand soap and bath soap

**International Class:** 003



**First Use Date:****First Use in Commerce Date:****Basis:** 1(b)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2002-03-11 - Extension 1 granted

2002-02-20 - Extension 1 filed

2002-02-26 - PAPER RECEIVED

2001-11-06 - Notice of allowance - mailed

2001-08-14 - Published for opposition

2001-07-25 - Notice of publication

2001-05-09 - Approved for Pub - Principal Register (Initial exam)

2001-03-07 - Communication received from applicant

2000-10-17 - Non-final action mailed

2000-10-12 - Case file assigned to examining attorney

---

**CONTACT INFORMATION**

---

**Correspondent (Owner)**

SANA HAKIM (Attorney of record)

SANA HAKIM

BELL BOYD &amp; LLOYD LLC

PO BOX 1135

CHICAGO IL 60690-1135

United States

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 11/19/2002 17:10:35 ET**

**Serial Number:** 76042343

**Registration Number:** (NOT AVAILABLE)

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**Date of Status:** 2002-03-25

**Filing Date:** 2000-05-05

**The Notice of Allowance Date is:** 2001-11-06

**Registration Date:** (DATE NOT AVAILABLE)

**Law Office Assigned:** TMO Law Office 110

**Attorney Assigned:**  
SMITH REBECCA A Employee Location

**Current Location:** 701 -Intent To Use Unit

**Date In Location:** 2002-04-05

---

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1. Girl Squared, LLC

**Address:**

Girl Squared, LLC  
270 Lafayette St. Suite 1301  
New York, NY 10012  
United States

**State or Country Where Organized:** New York

**Legal Entity Type:** Other

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**GOODS AND/OR SERVICES**

---

comic books, newspaper cartoon strips, children's books, trading cards, invitation cards, greeting cards, cardboard gift boxes, gift wrapping paper, calendars, note pads, memo pads, notebooks, ring binders, address books, coloring and activity books, playing cards, pencils, pencil cases, felt-tip markers, crayons, erasers, pencil sharpeners, pens, stickers, sticker albums, paper staplers, and stationary

**International Class:** 016

**First Use Date:****First Use in Commerce Date:****Basis:** 1(b)

---

**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2002-03-25 - Extension 1 granted

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United States

**State or Country Where Organized:** New York

**Legal Entity Type:** Other

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**GOODS AND/OR SERVICES**

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comic books, newspaper cartoon strips, children's books, trading cards, invitation cards, greeting cards, cardboard gift boxes, gift wrapping paper, calendars, note pads, memo pads, notebooks, ring binders, address books, coloring and activity books, playing cards, pencils, pencil cases, felt-tip markers, crayons, erasers, pencil sharpeners, pens, stickers, sticker albums, paper staplers, and stationary

**International Class:** 016

**First Use Date:**

**First Use in Commerce Date:**

**Basis:** 1(b)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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